

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant : Kambe et al.

Serial No.: 08/962,362

Filed : October 31, 1997

For : PHOSPHORS

Docket No.: N19.12-0006

Group Art Unit: 2879

Examiner: Day

CERTIFICATION OF TELEFACSIMILE TRANSMISSION T3

Assistant Commissioner for Patents
Washington, D.C. 20231

(703) 308-7382

Sir:

I certify that the following papers are being telefacsimile transmitted to the U.S. Patent and Trademark Office on the date shown below:

1. Arguments For Discussion In A Phone Interview.

WESTMAN, CHAMPLIN & KELLY, P.A.

Date: June 22, 2000

By: Peter S. Dardi
Peter S. Dardi, Ph.D., Reg. No. 39,650
Suite 1600 - International Centre
900 Second Avenue South
Minneapolis, Minnesota 55402-3319
Phone: (612) 334-3222
Fax: (612) 334-3312

PSD:nw

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ARGUMENTS FOR DISCUSSION IN A PHONE INTERVIEW

Assistant Commissioner for Patents
Washington, D.C. 20231

By Facsimile
June 22, 2000

Sir:

1) In response to a Declaration submitted by Applicants, the Examiner has indicated that the Declaration had no probative value. The Examiner cited for support MPEP 716.01(c). Applicants respectfully assert that the Examiner incorrectly cited the MPEP and the underlying case law.

In the Office Action, the Examiner stated that "To be of probative value, any objective evidence should be supported by actual proof." However, the MPEP 716.01(c) states "[opinion] testimony is entitled to consideration and some weight so long as the opinion is not on the ultimate legal conclusion." "In assessing the probative value of an expert opinion, the examiner must consider the nature of the matter sought to be established, the strength of any opposing evidence, the interest of the expert in the outcome of the case, and the presence and absence of factual support for the expert's opinion."

In the present case, the nature of the matter sought to be

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established is at best speculative. It is difficult to establish that a method that has never been tried is not a useful approach. An undue amount of experimentation is required in the present case because the wet filtration techniques suggested by Jaskie is not an established procedure. To establish a new method of purifying nanoparticles based on the minimal guidance from the Jaskie patent is at most an invitation to perform extensive research in the hopes that it may work. It is unreasonable to ask an Applicant to carry out an undue amount of research just to establish that an undue amount of research is needed. With respect to the Jaskie suggestion, an expert in the field addressed the relevant issues regarding the mere suggestion in the Jaskie patent.

In the present case, there is no contrary evidence. The only hint of contrary evidence is a mere suggestion in the Jaskie patent. The Jaskie patent does not present any experimental results. Almost five years after the Jaskie patent issued, there is no public knowledge of successful application of the Jaskie approach. This is objective evidence against the Jaskie suggestion.

Professor Singh has no interest to be gained in the present case. Dr. Singh is an expert who has consulted with many important companies in the field of nanotechnology. As noted in the Declaration, Dr. Singh has no equity interest in NanoGram. Any expert will require payment for their time. He is not an inventor and has not consulted for NanoGram in the area of phosphors, except for the Declaration under discussion. Dr. Singh has no interest in the outcome of the present patent application.

- 2) Applicants firmly believe that Dr. Singh's Declaration is not self contradictory. Dr. Singh was addressing a speculative proposition, the separation of nanoparticles by size using chromatography. To state that the procedure would be difficult or impossible to scale up is one possible explanation of why no work has been reported on the approach or related approaches to date. Since no work had been done previously, an undue amount of experimentation would be required to attempt to practice the technique. This argumentation is completely consistent.
- 3) Applicants do not deny that generally chromatography is a well developed field for chemical and biochemical separation. However, this experience does not extend into the separation of solid particles. The Examiner cited isotope separation of lithium in 1938. However, the Examiner did not provide a copy of the Instruments of Science and Historical Encyclopedia, page 108 with the Office Action. This reference is not readily available to Applicants. Regardless, the separation of lithium isotopes was likely performed with gas chromatography, which involves small molecules vaporized in a gas stream. The chromatography could not have been performed by particle size separation since isotopes (differing only in the number of neutrons) do not have different sizes, but only different masses. There could not have been particles involved in the separation since particles cannot be used to separate isotopes. Applicants respectfully request that the Examiner check the reference for the type of separation being performed and forward a copy to Applicants if he maintains his position regarding the reference teaching the separation of solid

particles. Therefore, Applicants do not believe that there is any evidence whatsoever contrary to their position and the expert opinion of Professor Singh that an undue amount of experimentation would be required to attempt to separate nanoparticles by size using wet filtration described in the Jaskie patent.

4. Applicants believe that they have met their burden. Furthermore, Applicants do not see what additional evidence can be presented reasonably to further support of their position. If the above arguments are not persuasive, Applicants sincerely and respectfully request some specific guidance from Examiner in a subsequent phone conference.

Respectfully submitted,

WESTMAN, CHAMPLIN & KELLY, P.A.

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Minneapolis, Minnesota 55402-3319
Phone: (612) 334-3222 Fax: (612) 334-3312

PSD:nw